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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,796	05/30/2001	Kanada Nakayasu	037267-0138	5691
22428	7590	06/01/2005	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			NG, CHRISTINE Y	
			ART UNIT	PAPER NUMBER
			2663	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,796

Applicant(s)

NAKAYASU, KANADA

Examiner

Christine Ng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-8 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) 2-4 and 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-8 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5-8 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,718,173 to Somani et al.

Referring to claim 1, Somani et al disclose in Figures 1 and 2 a system for monitoring a mobile terminal device (MS 16), comprising :

(a) A base station system (BS 14, BSC 18, MSC 20, VLR 28) connected to said mobile terminal device (MS 16) through radio signals (radio channels). Refer to Column 1, lines 26-52 and lines 64-67.

(b) A network (wired network 22) connected to said base station system through wires. Refer to Column 1, lines 40-42.

(c) A monitoring device (HLR 26) which is connected to said network and which monitors said mobile terminal device, said monitoring device receiving an access from said mobile terminal device through both said base station system and said network.

Refer to Column 1, lines 58-67 and Column 2, lines 1-22.

Wherein when said base station system receives a first request (Figure 4, CDR 40) to connect thereto from said mobile terminal device, said base station system checks whether mobile terminal device is registered in said base station system. As shown in Figure 4, MSC 20a receives a request from MS 16b to answer the call from MS 16a. MSC 20a queries VLR 28a to determine if MS 16b is registered and located within associated first location area 24a. Refer to Column 2, lines 26-38.

Wherein when said network receives a second request (Figure 4, query 42) to connect thereto from said base station system, said network checks whether said mobile terminal device transmitting said first request is registered in said network. As shown in Figure 4, if MS 16b is not located in first location area 24a, MSC 20a sends a query 42 to HLR 26 through wired network 22 for MS 16b's location information. Refer to Column 2, lines 38-56.

Wherein when said base station system confirms that said CDMA mobile terminal device is registered in base station system and said network confirms that said mobile terminal device is registered in said network, a radio interface (radio channels) is established between said mobile terminal device and base station system and a wire interface (wired network 22) is established between base station system and said monitoring device. HLR 26 determines the location of MS 16b and sends the location information back to MSC 20a, so that MS 16b is registered with both the base station system of first location area 24a and HLR 26 through wired network 22. Refer to Column 1, lines 32-40 and Column 2, lines 42-56.

Referring to claim 5, Somani et al disclose in Figures 1, 2 and 4 that the mobile terminal device (MS 16) transmits a non-ordinary call to said base station system (BS 14, BSC 18, MSC 20, VLR 28) as said first request (CDR 40). Refer to Column 2, lines 26-38.

Referring to claim 6, Somani et al disclose in Figure 8 a system for monitoring a mobile terminal device (MS 16), comprising:

- (a) A base station system (BS 214, BSC 218, MSC 220, VLR 228).
- (b) A core network (wired network 222) connected to said base station system through wires.
- (c) A server (global database server 102) which monitors said base station system connected to said core network through wires.
- (d) A monitoring device (HLR 226) connected to said server through wires, said monitoring device monitoring and controlling said base station system through both said server and said core network.
- (e) A mobile terminal device (Figure 2, MS 16) connected to said base station system through radio signals (radio channels). Refer to the rejection of claim 1. Refer also to Column 1, line 26 to Column 2, line 22; Column 7, lines 29-40 and Column 15, lines 26-48.

Wherein when said base station system receives a first request (Figure 4, CDR 40) to connect thereto from said mobile terminal device, said base station system checks whether mobile terminal device is registered in said base station system. Refer to the rejection of claim 1.

Wherein when said network receives a second request (Figure 4, query 42) to connect thereto from said base station system, said network checks whether said mobile terminal device transmitting said first request is registered in said network. Refer to the rejection of claim 1.

Wherein when said base station system confirms that said CDMA mobile terminal device is registered in base station system and said network confirms that said mobile terminal device is registered in said network, a radio interface (radio channels) is established between said mobile terminal device and base station system and a wire interface (wired network 22) is established between base station system and said monitoring device by way of said core network and said server. Refer to the rejection of claim 1. Also, server 102 includes HLR 226.

Referring to claim 7, Somani et al disclose in Figures 2 and 8 that the system further comprises a terminal connected to said mobile terminal device (MS 16) for controlling an operation of said monitoring device (HLR 226). The HLR 226 stores and updates the position of the mobile terminal device (MS 16), which may be a cellular telephone. Refer to Column 1, lines 11-15 and Column 2, lines 1-22.

Referring to claim 8, refer to the rejection of claim 1. Furthermore, the method comprises:

On receipt of a first request (Figure 4, CDR 40) to connect to said base station system, from said mobile terminal device, checking whether mobile terminal device is registered in said base station system, said step being carried out by said CDMA base station system (MSC 20a and VLR 28a). Refer to the rejection of claim 1.

On receipt of a second request to connect to said network, from said base station system, checking whether said mobile terminal device transmitting said first request is registered in said network, said step being carried out by said network (HLR 26 through wired network 22). Refer to the rejection of claim 1.

Wherein when said base station system confirms that said CDMA mobile terminal device is registered in base station system and said network confirms that said mobile terminal device is registered in said network, a radio interface (radio channels) is established between said mobile terminal device and base station system and a wire interface (wired network 22) is established between base station system and said monitoring device. Refer to the rejection of claim 1.

Referring to claim 12, refer to the rejection of claim 5.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,718,173 to Somani et al.

Referring to claim 13, refer to the rejection of claims 1, 6 and 8.

Somani et al do not specifically disclose that step (e) and step (f) are carried out by said base station system.

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However, as shown in Figure 1, establishing a radio interface between the base station system and the mobile terminal device must be done by the base station system since the BSC 18 (part of the base station system) manages the radio resources and allocates radio channels. Refer to Column 1, lines 36-40. Furthermore, establishing a wire interface between said base station system and said server must be done by the base station system since the MSC 20 (part of the base station system) coordinates location registration and call delivery for mobiles 16 and has access to location information databases in the mobile network. Refer to Column 1, lines 40-52. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include that step (e) and step (f) are carried out by said base station system; the motivation being that the base station system includes the components to coordinate the transfer of information between the network and the mobile units.

Somani et al also do not specifically disclose that step (g) is carried out by said server.

However, as shown in Figure 8, the server 102 contains HLR 226, so it must be used to connect HLR 226 to the mobile unit. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include that step (g) is carried out by said server; the motivation being that the server 102 controls the monitoring device.

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5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,718,173 to Somani et al in view of U.S. Patent No. 6,321,096 to Lautenschlager et al.

Referring to claim 14, refer to the rejection of claim 13.

Somani et al do not disclose step (a) transmitting a first request to connect to said mobile terminal device as a trial, said step (a) being carried out by said server.

Lautenschlager et al disclose in Figure 3a that an HLR has "to perform a test to determine whether or not the terminal MT is registered in the mobile radio network MN". Refer to Column 5, line 49 to Column 6, line 16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include step (a) transmitting a first request to connect to said mobile terminal device as a trial, said step (a) being carried out by said server; the motivation being that if the MT is registered in the network, the communication between a source T and a destination MT can be established.


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Ng whose telephone number is (571) 272-3124. The examiner can normally be reached on M-F; 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571) 272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

C. Ng 
May 2, 2005


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PRIMARY EXAMINED